

## **REMARKS**

### **Status of the Claims**

Claims 1-18 are pending in this application. Claims 17 and 18 are withdrawn from consideration as being drawn to a non-elected invention, and Claims 7, 8, and 10 are withdrawn from consideration as being drawn to non-elected species. Accordingly, Claims 1-6, 9, and 11-16 are presently under examination, each of which was rejected by the Patent and Trademark Office ("PTO") in the January 23, 2004, Office Action.

Respectfully, Applicants request reconsideration of the rejected claims in view of the following remarks.

### **Rejection of Claim 12 under 35 U.S.C. § 112, Second Paragraph**

Claim 12 was rejected in the January 23, 2004 Office Action under 35 U.S.C. § 112, second paragraph, as being indefinite. It is the PTO's position that Applicants' inclusion of the generic term "auxiliary agents" in Claim 12, along with species that could be encompassed by that genus renders Claim 12 indefinite.

Respectfully, Applicants traverse the rejection of Claim 12 as being indefinite, as follows.  
As stated in the MPEP,

The mere fact that a compound may be embraced by more than one member of a Markush group recited in the claim does not necessarily render the scope of the claim unclear. For example, the Markush group, "selected from the group consisting of amino, halogen, nitro, chloro and alkyl" should be acceptable even though "halogen" is generic to "chloro."

MPEP § 2173.05(h)(I).

Applicants respectfully maintain that the terms, “fillers, pigments, hydrophobing agents, and auxiliary agents” of Claim 12 each differ in scope, and although one member of this group may be embraced by another, such a fact would not render the scope of the Claim 12 indefinite.

Examples of auxiliary agents and examples fillers are disclosed on page 9, second full paragraph. Pigments and hydrophobing agents are well-known by one of ordinary skill in the art, and examples are provided on page 9, second full paragraph and in the Examples. Therefore, although each differs in scope, this feature in no way renders Claim 12 indefinite.

Accordingly, Applicants respectfully request that this rejection be withdrawn and Claim 12 be allowed.

**Rejection of Claims 1-6, 9, 11, 12, and 16 under 35 U.S.C. § 102(e)**

Claims 1-6, 9, 11, 12, and 16 were rejected in the January 23, 2004 Office Action under 35 U.S.C. § 102(e), as being anticipated by *Kastl et al.* (U.S. Patent No. 6,150,436). It is the PTO's position that Example 1 of *Kastl et al.* (col. 4) shows a method for producing a plate comprising compounding epoxidized linseed oil and a partial ester of maleic anhydride and dipropylene glycol, pre-crosslinking at 50°C, compounding fillers therewith, and curing the plate at 180°C, which anticipates Claims 1-6, 9, 11, 12, and 16. Respectfully, Applicants traverse this rejection as follows.

Example 1 of *Kastl et al.* (col. 4) discloses a treatment of the stated mixture at 50°C, followed by a treatment of the mixture at 180°C. Respectfully, Applicants note that the reaction at 50°C and the reaction at 180°C constitute the same reaction, which is merely driven to a

greater degree of completion at the higher temperature. Thus, “pre-crosslinking” (col. 4, line 49) at 50°C to the extent necessary to form a viscous mass (including fillers, col. 4, line 54) and the subsequent “crosslinking” (col. 4, line 58) at 180°C are the identical reaction.

In contrast, Claims 1-6, 9, 11, 12, and 16 of the present invention are drawn to a method in which the pre-crosslinking reaction is step (2) is “separate from” the curing reaction in step (4) (Claim 1, translation document page 4). The specification discloses that “at least two different reactions I and II occur in the mixture obtained by compounding” and “[r]eaction II, which is different from reaction I, does not proceed significantly under the reaction conditions for pre-crosslinking” (translation document page 4). One example provided is:

. . .when partially epoxidized carboxylic acid esters of unsaturated fatty acids are used in a first crosslinking step, the epoxy groups are preferably completely reacted, and in a second crosslinking step the remaining unsaturated double bonds are crosslinked by radical polymerization, for example.

Translation document page 6, bottom-page 7, top.

For at least these reasons, Applicants respectfully maintain that the *Kastl et al.* (U.S. Patent No. 6,150,436) does not anticipate their claimed invention. Accordingly, Applicants request that this rejection be removed and Claims 1-6, 9, 11, 12, and 16 be allowed.

#### **Rejection of Claims 13-15 under 35 U.S.C. § 103(a)**

Claims 13-15 were rejected in the January 23, 2004, Office Action under 35 U.S.C. § 103(a) as being obvious over *Kastl et al.* (U.S. Patent No. 6,150,436) as applied to Claims 1-6, 9, 11, and 12, in further view of *Höver et al.* (U.S. Patent No. 5,179,149).

Respectfully, Applicants traverse this rejection on the basis that the present invention and *Kastl et al.* (U.S. Patent No. 6,150,436) were commonly owned or subject to an obligation to assign to the same entity at the time the invention was made. Accordingly, under 35 U.S.C. § 103(c), *Kastl et al.* is thereby disqualified as prior art against the claimed invention for a 35 U.S.C. § 103 rejection (*see also* MPEP § 706.02(1)(1)).

The assignments to DLW Aktiengesellschaft in the present patent application (Application Serial No. 10/031,217) were filed with the PTO on January 15, 2002, copies of which are of record in this application.

Respectfully, Applicants maintain that because *Kastl et al.* is disqualified as prior art for § 103 purposes, and because *Höver et al.* alone does not render Claims 13-15 obvious under 35 U.S.C. § 103(a), Applicants respectfully request that this rejection be removed and Claims 13-15 be allowed.

#### **Amendment to Claims**

Applicants have amended Claim 7 to properly depend from Claim 5, which recites “polycarboxylic acid,” rather than Claim 6, which does not. Respectfully, Applicants request entry of this Amendment.

**CONCLUSION**

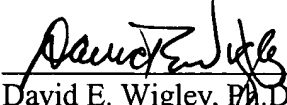
Applicants believe the Response herein places the claims in condition for allowance. Accordingly, such action is respectfully requested.

No additional fees are believed due, however, the Commissioner is hereby authorized to charge any deficiencies which may be required, or credit any overpayment, to Deposit Account Number 09-0528.

Early and favorable consideration is respectfully solicited. If the Examiner believes any informalities remain in the application that can be resolved by telephone interview, a telephone call to the undersigned attorney is requested.

Respectfully submitted,

July 16, 2004  
Date

  
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